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FAX COVER LETTER

April 13, 2007

TO: Examiner Arthur D. Duran
COMPANY: Commissioner for Patents - Art Unit 3622
FAX: 571-273-8300

FROM: David A. Prange
DIRECT DIAL: 612-607-7263
E-MAIL: DPrange@oppenheimer.com
RE: Serial No. 09/444,774

COMMENTS: Attached please find a copy of the Reply Brief in response to the Examiner's Answer mailed on February 16, 2007.

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Completed by : Debra J. Bruck / 7375

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**Applicant:** Michael G. Mikurak**Serial No.:** 09/444,774**Filing Date:** November 22, 1999**Title:** ENHANCED VISIBILITY DURING
INSTALLATION MANAGEMENT
IN A NETWORK-BASED SUPPLY
CHAIN ENVIRONMENT**Group Art Unit:** 3622**Examiner:** Arthur D. Duran**Docket No:** 60021-334801

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P.O. Box 1450
Alexandria, VA 22313-1450

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Appeal Brief - Patents, Commissioner for Patents, P.O. Box
1450, Alexandria, VA 22313-1450 on the date shown below.

Debra J. Bruck 4-13-07
Debra J. Bruck Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dear Sir:

Appellant submits this Reply Brief in response to the Examiner's Answer mailed on

February 16, 2007.

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(1) STATUS OF CLAIMS

As set forth in the Appeal Brief, claims 70, 73-76, 82-87, 90-93, 99-104, 107-109, and 112-115 are pending and are herein appealed. Claims 1-69, 71-72, 77-81, 88-89, 94-98, 105-106, and 110-111 have been cancelled. The Examiner rejected independent claims 70, 87 and 104, under 35 U.S.C. § 103(a) as being unpatentable over *Webber*, U.S. Patent No. 6,167,378, in view of *Whipple et al.*, U.S. Patent No. 6,289,385 B1. Additionally, the Examiner rejected dependent claims 73, 90 and 107 under 35 U.S.C. § 103(a) as being unpatentable over *Webber*, U.S. Patent No. 6,167,378, in view of *Whipple et al.*, U.S. Patent No. 6,289,385 B1.

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(2) GROUNDS OF REJECTION TO BE REVIEWED

Appellants respectfully submit this Reply Brief for consideration. Appellant's opening Appeal Brief addressed the arguments set forth in the "Grounds of Rejection" section of the Examiner's Answer. Appellant submits this Reply Brief to address some of the comments made in the "Response to Arguments" section on pages 13-21 of the Examiner's Answer.

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(3) ARGUMENT

A. Citation and Argument Relating to the Evaluative Requirement of Subpart (c) Fails to Demonstrate that the Claims Are Obvious.

Claim 70 subpart (c) requires a framework user “to use and evaluate the information provided by the service provider via the network and the manufacturer to match the service to the offerings, evaluating factors that include cost and service provider requirements[.]”¹ The Examiner’s Answer concedes that the purported teaching or suggestion of that claim limitation is found in *Webber*, U.S. Patent No. 6,167,378, without reliance on *Whipple*, U.S. Patent No. 6,289,385. (Answer at 14-15.) Reliance on *Webber*, however, is misplaced, as the passages relied upon do not teach or suggest the limitation of subpart (c).

The Examiner provides a string citation of purportedly applicable passages that demonstrate that the claim limitation is obvious. These passages, however, fail to demonstrate how the claim language is an obvious improvement over the prior art. As Appellant’s Appeal Brief has anticipated and addressed the citation to column 20, lines 29-43 of *Webber*, the remaining citations can be dispatched with equal efficiency. Reliance on Figure 4 in itself does not disclose or teach the evaluation of information. *Webber*, at Fig. 4. Instead, Figure 4 discloses a graphic detailing the contract execution flow of an exemplary use of the *Webber* invention. It simply does not provide any illustration or other suggestion of a “comparison, evaluation, and matching” that is claimed to occur. (Answer, at 15.) If anything, Figure 4 illustrates a functioning supply chain that automates the use of contracts. What Figure 4 fails to illustrate is the evaluation of services or goods provided by the individual participating members of the supply chain.

¹ Related independent claims 87 and 104 contain a similar claim limitation subpart (c).

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The Examiner identifies two other passages in *Webber* for discussion, column 9, lines 47-52, and column 19, lines 9-26. (*Id.* at 15-16.) The passage at column 9 addresses execution of a digital contract, noting that contracts are linked for the supply of goods or services. *Webber*, at 9:47-52. This passage in itself does not teach or suggest the evaluation limitation that is identified in the pending claims at issue.

Similarly, column 19, lines 9-26 of *Webber* fails to disclose teaching or suggestion of the evaluation limitation, and in fact teaches away from such a limitation. That passage cites to Figure 8 as an example of an *established* supply chain using the invention of *Webber*. *Webber*, at 19:9-10. There, the contracts creating the relationships of the supply chain “have previously been stored and authorized[.]” *Id.* at 19:16-17. Thus, when an event is initiated, each contract of the supply chain is “automatically linked” to the next, falling in line for use much like a falling line of dominos. *Id.* at 17-18. The paragraph continues, touting the benefit of automation, *id.* at 19-26, and stating that the “goal”, however, is to “fully integrate the entire supply chain for all products so that all business can be automated and streamlined.” *Id.* What is not taught or suggested is an evaluation of the contracts or offerings of the supply chain participants. Instead, the contracts are “previously authorized” and ready upon initiation of an event at the beginning of the supply chain. Thus, such automation would not include the evaluation as at that stage the contract is already “previously stored and authorized.” *Webber*, 19:15-17.

In fact, the passage teaches away from the evaluation of information provided by the service provider because of the expressed goal and disclosed intent of creating a supply chain that is “automated and streamlined”. *Id.* at 19:23-26. The automation feature of *Webber* implies that no evaluation occurs because movement along the steps of the supply chain occurs without interaction to decide the selection of the next step. Thus, to one of ordinary skill in the art,

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Webber would teach away from incorporating such evaluation through the use of the automation function. Evaluation would require consideration of the next step, which is not contemplated by *Webber*.

Finally, without discussion reliance is placed on language in *Webber* at column 8, line 65 to column 9, line 17. Predictably, that language also does not address the evaluation limitation claimed by Appellant. Instead, the language discusses the capture of information and provision of links, but continues with the "link[ing]" of contracts that forms the precursor to the automation feature discussed in later sections of the specification. *See Webber*, 9:12-15; 9:2-4. If anything, this section again promotes the intended benefit of the *Webber* invention — automation. What it does not reflect is an evaluation of information as claimed.

In combination these citations fair no better, all teaching toward the stated goal of automating the supply chain process. The passages fail to be a sum greater than the parts, as they do not provide teaching or suggestion of *evaluating* the available products or services offered or requested. The language relied upon does not consider the evaluative step, instead focusing on automating the supply chain process with the implementation and use of pre-authorized contracts, which would necessarily have already been evaluated. In such a case the prior art teaches away from evaluation based on the focus of automating the supply chain process; it would not lead one of ordinary skill in the art to consider the evaluation step as an obvious improvement. Thus the language does not serve to obviate the claims on appeal, and without other support or reasoning as to what common knowledge or common sense of a person of ordinary skill in the art, the proper conclusion is that the claim language is not obvious in light of the cited reference passages.

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B. Remaining Responses of the Examiner.

The Examiner provided further response to the remaining arguments presented in Appellant's Appeal Brief. After review of the Examiner's response, Appellant respectfully directs the Board to its arguments contained in the Appeal Brief.

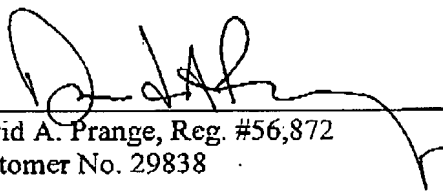
(4) CONCLUSION

Pending claims 70, 73-76, 82-87, 90-93, 99-104, 107-109, and 112-115 remain rejected under 35 U.S.C. § 103(a). Appellant respectfully asserts that the Examiner has not established a *prima facie* case of obviousness as demonstrated above and requests that the Board of Patent Appeals and Interferences reverse the Examiner's decision.

Should any additional fees be necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference # 60021-334801).

Respectfully submitted,

By


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